UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
07/010,106	02/02/87	TERRELL	[illegible]

THE BOC GROUP, INC.
PATENT, TRADEMARK & LICENSING DEPART.
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EXAMINER	
COLEMAN W	
ART UNIT	**PAPER NUMBER**
125	2

DATE MAILED: 05/04/87

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449
4. ☐ Notice of Informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1-7 are pending in the application.
   Of the above, claim 7 is withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-6 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

During a telephone conversation with Chris P. Konkol on April 13, 1987 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-6. Affirmation of this election must be made by applicant in responding to this Office action. Claim 7 is withdrawn from further consideration by the examiner as being drawn to a nonelected invention. See 37 CFR 1.142(b).

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-6, drawn to anesthesia inducing compositions and methods of inducing anesthesia in warm blooded animals, classified in Class 514, subclass 722.

II. Claim 7, drawn to a method for producing a compound, classified in Class 568, subclass 683.

The inventions above are independent and distinct, each from the other, as they have acquired a separate staus in the art as a separate subject for inventive effort, require independent searches and are separately classified as shown above. It is also noted that a reference to the method of making a compound under 35 USC 103 would not be a reference to the method and compositions for inducing anesthesia.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification restriction for examination purposes as indicated is proper.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

> (a)the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-6 are rejected under 35 U.S.C. 102 (a) as anticipated by or, in the alternative, under 35 U.S.C. 103 as obvious over Russell et al patent.

It is clear from column 9, lines 15-30 that all the compound were tested for inducing anesthesia.

Claims 1-6 are rejected under 35 U.S.C. 103 as being unpatentable over the Terrell et al, the Terrell and the Bagnall patents. The Terrell et al teaches the 1-choro derivative of applicant's compound for inducing anethesia including in oxygen. The Terrell patent teaches the 1-bromo derivative for inducing anesthesia including in oxygen. The Bagnall teaches a similar compound wherein the 1-fluoro can be substituted for inducing anesthesia. In view of this, applicant's 1-fluoro derivative for inducing anesthesia would be obvious in the absnece of a showing.

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4/28/87

JEROME D. GOLDBERG
EXAMINER
GROUP ART UNIT 125